

REMARKS

Claims 26-28 and 31 are currently pending. Claim 1 has been amended to correct a minor typographical error. No new matter has been added by the Amendment D after Final Office Action.

Rejection of the Claims Under 35 U.S.C. §103(a)

Reconsideration is requested of the rejection of claims 26-28 and 31 under 35 U.S.C. §103(a) as being unpatentable over US 6,849,057B2 to Satou, et al. in view of US 5,728,058 to Ouellette, et al.

Claim 26 is directed to a method of supporting a portion of a body. The method comprises: attaching one end of an elastic band to skin on the body using an adhesive; wrapping the elastic band around the portion of the body; and securing a plurality of fingers that project from an opposing end of the elastic band to an exposed section of the elastic band. The plurality of fingers includes at least one finger that extends from the end of the elastic band along a lateral edge of the elastic band, at least one finger that extends from the end of the elastic band along an opposing lateral edge of the elastic band, and at least one finger that extends from a midsection of the end on the elastic band.

Satou, et al. is directed to a pressure-sensitive adhesive tape for providing support to a joint of the body, wherein the adhesive tape is configured such to allow a laymen to wear the adhesive tape comfortably and efficiently. Specifically, the adhesive tape includes a cut line in the tape portions of the adhesive tape to allow winding of the tape portions around the joint of the body. Additionally, the tape includes a non-adherent portion that contacts the inner side site of the joint of the body; that is, the adhesive tape portions **do not contact**

the inner side site of the joint where the skin is sensible and spontaneous perspiration commonly occurs. This configuration allows the adhesive tape to be applied easily, and further prevents incompatibility at the internal site of the joint and skin irritation due to the tape getting stuffy. When using the adhesive tape, first the non-adherent portion 14 is applied to an inner side site of a joint portion and then one of the pressure-sensitive adhesive tape portions 6 separated by the cut line 3 is wound around an outer side site of the joint portion. This makes it possible to apply the pressure-sensitive adhesive tape so that one of the pressure-sensitive adhesive tape portions 6 can be superposed on the other of the pressure-sensitive adhesive tape portions 6 in the front of the knee joint portion.

Significantly, as recognized by the Office, Satou, et al. fails to teach or suggest the at least one finger that extends from a midsection of its tape portion 6, such as is required of the elastic band used in the method of Applicants' claim 26. Accordingly, the Office combines Ouellette, et al. with Satou, et al. in an attempt to find each and every limitation of Applicants' claimed invention.

Ouellette, et al. is directed to an elastic knee wrap comprising a piece of flexible web having a first end and a second end and an elastic portion there between stretchable along a longitudinal axis of the piece of flexible web. The piece of flexible web has a length great enough to encircle a user's knee during use such that said first and second ends overlap, the first end having a reclosable fastening system for attaching the first end to the piece of flexible web near the second end in order to hold the piece of flexible web around the user's knee when the piece of web is stretched. The piece of flexible web also has an aperture therein, the aperture is

intended to be aligned with the user's patella to establish a convenient locating point for wrapping the knee wrap around the user's knee. The piece of flexible web may further have a slit extending substantially longitudinally from the aperture enabling the user to extend the piece of flexible web transverse to the longitudinal axis at the aperture in order to accommodate bending of the user's knee. A plurality of thermal elements may be embedded in the piece of flexible web to apply thermal energy to the user's knee.¹

In order for the Office to show a *prima facie* case of obviousness, M.P.E.P. §2142 requires a clear articulation of the reasons why the claimed invention would have been obvious. Specifically, the Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 418, 82 USPQ2d 1385, 1396 (2007) noted that the burden lies initially with the Office to provide An explicit analysis supporting a rejection under 35 U.S.C. 103. "[R]ejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."² The Court in *KSR International* further identified a number of rationales to support a conclusion of obviousness which are consistent with the proper "functional approach" to the determination of obviousness as laid down in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Specifically, as previously required by the TSM (teaching, suggestion, motivation) approach to obviousness, one exemplary rationale indicated requires some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed

¹ Ouellette et al., claim 1.

² *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

invention.

Specifically, to reject a claim based on this rationale, the Office must articulate the following: (1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings to arrive at each and every limitation of the claimed invention; (2) a finding that there was reasonable expectation of success; and (3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness. The Office has failed to meet its burden under number (1) above, as there is no apparent reason for one skilled in the art to combine the references to arrive at each and every limitation. It simply would not have been obvious to one skilled in the art to arrive at Applicants' claimed combinations.

As noted above, Satou, et al. teaches contacting a non-adhesive portion of its adhesive tape to the inner side site of a joint of the body, such as a knee. The tape portions of the adhesive tape are then wrapped around the outer side site of the joint (i.e., patella). As such, there is simply no reason for one skilled in the art to use an additional strap or tape portion such as is described with the flexible wrap of Ouellette, et al. in the adhesive tape of Satou, et al. More particularly, a close reading of the Satou, et al. reference actually discourages such a modification as using the strap would defeat the purpose of Satou, et al.

Specifically, Satou, et al. expressly teaches the cut lines for separating the tape portions of its adhesive tape so that the tape portions can wind around and adhere at the outer side

site of the joint.³ As shown in Figures 8-10 and 12-13, the tape portions are arranged such as to form an aperature through which the outer side site of the joint (i.e., patella) can show through.⁴ As commonly understood, this allows the joint to move freely, and thus, allows the user a freer range of motion at the joint.

If, however, a third tape portion was added at the midsection of the adhesive tape of Satou, et al., as is suggested by the Office, the tape portion would wrap across the top of the outer side site of the joint, restricting the movement of the joint, and thus, defeating the purpose of the two tape portions being separated by the cut line as is required in the adhesive tape of Satou, et al. There is simply no reason for one skilled in the art to make such a modification.

Based on the foregoing, one having ordinary skill in the art would simply not combine the optional third strap of Ouellette, et al. with the pressure-sensitive adhesive tape of Satou, et al. Accordingly, claim 26 is patentable over the combination of Satou, et al. and Ouellette, et al.

Claims 27, 28 and 31 depend directly or indirectly from claim 26 and are thus patentable over the cited references for the same reasons set forth above for claim 26, as well as for the additional limitations they require.

³ See Satou, et al. at col. 10, line 33 through col. 11, 6, describing Figures 8-11, in which the adhesive tape is being used on a knee joint of a user.

⁴ Applicants respectfully note that Ouellette, et al. also includes an aperature for the patella and include the straps only on the inner side site of the knee.

CONCLUSION

In light of the foregoing, Applicants request withdrawal of the rejections of claims 26-28 and 31 and allowance of all pending claims. The Commissioner is hereby authorized to charge any fee which may be required to Deposit Account No. 01-2384.

Respectfully Submitted,

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